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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,654	02/27/2004	William Harrison Allen	141647.00001-P1266US00	9187

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EXAMINER

SAADAT, CAMERON

ART UNIT	PAPER NUMBER
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3715

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/789,654	Applicant(s) ALLEN, WILLIAM HARRISON	
	Examiner Cameron Saadat	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/24/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, the antecedent basis for "said button" has not been clearly set forth. In claim 8, the antecedent basis for "said plurality of buttons", "the action of the figure", "said individual's mind's eye", and "the punctuation symbols" has not been clearly set forth.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soto et al. (USPN 6,954,199; hereinafter Soto) in view of Sameth et al. (USPN 5,882,202; hereinafter Sameth), further in view of Fioramonti (USPN 5,114,346).

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Regarding claim 1, Soto discloses an electronic book, comprising: a binder comprised of a rigid material and having a first section and a second section, both sections being pivotably associated with each other by a middle hinge portion (Col. 11, lines 43-51); a means for generating a plurality of audio sounds in response to an actuating signal (Col. 6, lines 43-47); a plurality of pages associated with the binder, each page comprising a first side and a second side, each page having a plurality of discrete regions comprising: a region comprising a set of printed instructions (See Fig. 1), a region comprising a three-dimensional structural graphic image (Col. 3, lines 55-58; Col. 6, line 65 – Col. 7, line 2), a region displaying a word (Col. 8, lines 63-65), a region displaying the spelling of the word (Col. 6, lines 50-51; Col. 9, lines 28-32); and providing an audible pronunciation aid (Col. 6, lines 54-56). Although Soto discloses a pronunciation aid, the reference does not explicitly disclose a region on the page for displaying a guide for pronunciation and a region for providing a definition of a word. However, Sameth teaches an apparatus for language instruction comprising a region for displaying a guide for pronunciation and a region for providing a definition of a word (See Sameth, Col. 5, lines 36-48; Col. 6, lines 61-62). Thus, in view of Sameth, it would have been obvious to modify the content of the book described in Soto, by displaying a guide for pronunciation and providing definitions, in order to reinforce language instruction by providing a visual representation in conjunction with audio (See Sameth, Col. 2, lines 28-35). In addition, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, ___ F.3d ___, 2004 WL 1068957 (Fed. Cir. May 13, 2004). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

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The combination of Soto and Sameth disclose all of the claimed subject matter with the exception of explicitly disclosing a word in three-dimensions. However, Fioramonti discloses a reading and writing aid for helping individuals with dyslexia, wherein words are presented in three dimensions so that the individual may determine whether or not a character is correctly oriented by distinguishing between the left and right sides of the characters (Col. 1, lines 38-52). In view of Fioramonti, it would have been obvious to an artisan to modify the language instruction apparatus described in the combination of Soto and Sameth, by providing three dimensional words so that the individual suffering from dyslexia may determine whether or not a character is correctly oriented by distinguishing between the left and right sides of the characters.

Regarding claim 2, Soto discloses a means for generating an audio sound comprising a circuit having a sound generator responsive to a signal; a plurality of user input interfaces each interface corresponding to a distinct sound or word, each interface being in electrical communication with said sound generator; a means for powering the sound generator; a memory storage means for storing at least one sound or word (Col. 6, lines 43-56; Col. 15, lines 52-63).

Regarding claim 3, Soto discloses a battery 63 (Col. 7, line 15).

Regarding claim 4, Soto discloses a speaker (Col. 4, lines 7-8).

Regarding claim 5, Soto discloses an input interface comprising an actuatable button 5.

Regarding claim 6, Soto discloses housing portions 1 and 2, the housing being associated with said binder (See Fig. 8).

Regarding claim 7, the combination of Soto and Sameth disclose all of the claimed subject matter with the exception of explicitly disclosing a word in three-dimensions. However, Fioramonti discloses a reading and writing aid for helping individuals with dyslexia, wherein words are presented in three

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dimensions so that the individual may determine whether or not a character is correctly oriented by distinguishing between the left and right sides of the characters (Col. 1, lines 38-52). In view of Fioramonti, it would have been obvious to an artisan to modify the language instruction apparatus described in the combination of Soto and Sameth, by providing three dimensional words so that the individual suffering from dyslexia may determine whether or not a character is correctly oriented by distinguishing between the left and right sides of the characters.

Allowable Subject Matter


Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph. Patentability is seen in, although not limited to independent claim 8 the combination of elements specifically claimed for teaching dyslexic individuals. The closest prior art of record does not teach or fairly suggest the claimed elements in the combination.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is (571) 272-4443. The examiner can normally be reached on M-F 8:00 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cameron Saadat
October 24, 2005


MONICA S. CARTER
PRIMARY EXAMINER
SPE, AU 3715